

REMARKS

Applicants respectfully request reconsideration of the present application in view of the following commentary.

I. Status of the Claims

No claim amendments are made in this response. Claims 1-16, 18, 25-26, 45-46, 62-63, 68 and 82-99 were previously cancelled. Claims 17, 19-24, 27-44, 47-61, 64-67 and 69-81 are pending.

II. Rejection of Claims under 35 U.S.C. §103(a)

Claims 17, 19-24, 27-44, 47-61, 64-67 and 69-81 are rejected under 35 U.S.C. §103(a) for alleged obviousness over U.S. Patent Application Publication No. US 2002/0065256 A1 by Karlsson et al. ("Karlsson"). Applicants respectfully traverse the rejection.

A. The rejection lacks any valid basis in the cited art

Karlsson relates to sterile formulations containing glucocorticosteroids, which have a broad particle size range. Specifically, Karlsson describes that the particles have "a mass median diameter of less than 10 μm , more preferably less than 5 μm ...[or] less than 1.0 μm " (page 2, paragraph [0017]). In contrast, the fluticasone particle size of the claimed invention is less than 0.2 μm , which enables sterilization of the composition by passing through a 0.2 μm filter, as recited in claim 17.

The Examiner contends that "[i]t is the position of the Examiner that the particles of Karlsson et al. can be passed through a 0.2 micron filter as claimed" (final Office Action, page 4, second full paragraph). The Examiner makes this conclusion based upon Karlsson's teaching that "the particles size can be in ultra fine form less than 1 micron," without providing any factual basis. Rather, the rationale appears to hinge on the Examiner's conjecture that because

the particles are small, it is obvious to the Examiner that they will pass through a 0.2 μm filter. This rationale is clearly false because it neglects the fact that particle size being less than 1 μm is not sufficiently small to pass a 0.2 μm filter. In the absence of any factual evidence from the prior art, the obviousness is improperly based on the Examiner's speculation.

Moreover, Applicants have consistently pointed out that Karlsson teaches *away* from sterilizing the composition by passing through a filter. In fact, Karlsson describes that a problem with filtration is that "most of the particles of glucocorticosteroid will be retained on the filter" (page 1, paragraph [0009]). To provide a solution to this acknowledged problem, Karlsson discloses in Example 1 that "all components, *other than the glucocorticosteroid*, can be produced by sterile filtration of their aqueous solutions." And again, in Example 4, where "all the components, *other than the budesonide*, were produced by sterile filtration of their aqueous solutions" (emphasis added). Accordingly, the cited reference teaches that sterile filtration of the active agent should be avoided, which directly contravenes the Examiner's contention.

The above argument was convincing to the Examiner at one point during the prosecution of this application. The Examiner acknowledged that the claims were not obvious in view of Karlsson because Karlsson does not teach sterilizing the fluticasone particles by passing the composition through a 0.2 μm filter. *See* the withdrawn rejection in the Office Action issued July 17, 2007, and reiterated in the Interview Summary dated October 3, 2007.

B. The claimed range of particle size is critical to the invention

The Examiner further requests Applicants "to show why their particle size is preferred over that of the prior art" (final Office Action, page 4 lines 4-5).

Pursuant to MPEP 2144.05, "Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims... In such a situation, the applicant must show that the

particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)."

One skilled in the art would have appreciated that the size range of the claimed invention is critical because any particles having a size of larger than 200 nm would be retained by the 0.2 μ m filter, thereby preventing filtration from being an effective means for sterilization. Indeed, Karlsson acknowledges and addresses this limitation by excluding the active agent from the filtration step. Instead, an aqueous solution is produced by sterile filtration, followed by combining the sterile aqueous solution with the active agent. *See* Karlsson, paragraphs [0044] and [0057]. In contrast, the claimed dispersion, including the fluticasone particles, can be filter sterilized. *See* specification, Example 2. As such, the claimed size range is critical in providing filtration as an effective protocol for sterilizing the composition of the invention.

In view of the foregoing, Applicants respectfully request withdrawal of the obviousness rejection under section 103.

CONCLUSION

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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